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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,933	03/23/2005	Declan Kelly	NL 020977	6613
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EXAMINER HARVEY, DAVID E				
ART UNIT 2621		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/528,933

Applicant(s)

KELLY ET AL.

Examiner

DAVID E. HARVEY

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3, 4 and 10 is/are allowed.
- 6) ☒ Claim(s) 6, 8, 9, and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date 3/16/2010
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The following prior art is noted:

A) US Patent Document #2001/0048481 to Hatano et al:

Hatano et al described a system in which "attendant information" is added to a video stream to indicate the size and location at which PIP images are to be displayed.

[Note: paragraphs 0045, 0049, 0061, 0072, 0077, 0078; and lines 6-8 of paragraph 0084].

B) US Patent #6,778,224 to Dagtas et al:

Dagtas et al has been cited because it describes a system in which a PIP is automatically placed at the "best" location of the main picture. The means for placing the PIP image in the main image may be located in the receiver or at the transmitter as shown in Figure 5.

C) US Patent Document #2003/0026423 to Unger et al:

Unger et al has been cited because, as shown on the cover page, it evidences that it was known for MPEG signals to have comprises main and PIP program streams (and respective decoders thereof).

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2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,784,528 to Yamane et al. in view of US Patent publication 2009/0016438 to McDade et al. and one of:

A) US Patent #6,070,236 to Winter; and

B) US Patent #5,907,659 to Yamauchi et al.

I. US Patent #5,784,528 to Yamane et al.:

Yamane et al. has been cited for it showing of a system for recording (Figure 2) and reproducing (Figure 3) video, audio and sub-picture information on a DVD. As shown in Figure 2, the system includes:

1) An input unit (e.g., @ 100) for receiving:

a) A first full size main picture video signal (@ St1); and

b) A second reduced size sub-picture signal (@ St2);

2) A signal combination unit (e.g., @ 200-900, and 1300) for combining the received signals into a TDM multiplexed information stream (@ St43); and

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3) An output unit (@ 1200) for recording the combined stream onto a DVD recording medium (@ M).

II. Differences:

Claim 8 differs from the showing of Yamane et al only in that:

- 1) Claim 8 recites that the reduced size picture signal is a second video signal; and
- 2) Claim 8 recites that the combined/multiplexed signal also includes a generated "control signal" for indicating the location that the reduced size video signal is placed within the main picture signal at display.

III. Obviousness:

- 1) The examiner maintains that one of ordinary skill in the art would have understood that the reduced size "sub-picture" information content of a DVD was known to have comprised any type of secondary video signal information including a "PIP" video signal. Such is evidenced via paragraph 0043 of US patent document #2009/0016438 to McDade et al:

"[0043]The digital sub-picture data that is divided out from the bitstream and stored in the sub-picture buffer 46 may be encoded in a number of ways, such as MPEG-1, MPEG-2, etc. The digital sub-picture data stored in the sub-picture buffer 46 is decoded by a sub-picture decoder 56 using the appropriate decoding process to recover the original sub-picture data and a memory buffer 66 (typically RAM). Sub-picture data includes data representing a secondary video element that is desired to be combined with the primary video (output from the video decoder 54). Examples of a sub-picture include picture-in-picture ("PIP"), on-screen text and menus, close captioning, or any other type of video element added to, combined with, or overlaid on, the primary video. As previously described, the decoded digital sub-picture data is input to the mixer 74 for mixing with the decoded digital video data from the video decoder 54." (Emphasis added)

As such, the examiner maintains that it would have been obvious to one of ordinary skill in the art to have modified the system disclosed by Yamane et al to record sub-picture information representative of a reduced size PIP video signal.

2) When encoding sub-picture data for recording on a DVD, it was known to have generated and added a control to the combined/multiplexed signal indicative of the location in the main video signal at which the sub-picture video signal was to be overlaid; i.e., such being evidenced via the showing of Winter [note lines 31-33 in column 4] or Yamaguchi et al [note: Figures 11A-C and 13A]. The examiner maintains that it would have been obvious to one of ordinary skill in the art to have further modified the system disclosed by Yamane et al to have includes means for generating and adding such sub-picture display position controlling control signals to the combined/multiplexed signal to control the display position of the PIP video signal.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,784,528 to Yamane et al, in view of US Patent publication 2009/0016438 to McDade et al, and one of:

A) US Patent #6,070,236 to Winter; and

B) US Patent #5,907,659 to Yamauchi et al.

for the same reasons that were set forth above for claim 8.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,784,528 to Yamane et al, in view of US Patent publication 2009/0016438 to McDade et al, and one of:

A) US Patent #6,070,236 to Winter; and

B) US Patent #5,907,659 to Yamauchi et al.

for the same reasons that were set forth above for claim 8.

Additionally:

The examiner takes Official Notice that it was notoriously well known in the DVD art for DVDs to have been encoded with a plurality of sub-picture streams and a menu to select the desired one to be displayed. The examiner maintains that it would have been obvious to one of ordinary skill in the art to have provided such a conventional feature to the modified system of Yamane et al

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6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,784,528 to Yamane et al. in view of US Patent publication 2009/0016438 to McDade et al. and one of:

A) US Patent #6,070,236 to Winter; and

B) US Patent #5,907,659 to Yamauchi et al.

for the same reasons that were set forth above for claim 8.

Additionally:

The examiner maintains that standard DVD format includes, by definition, at least one playlist.

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7. The following is an examiner's statement of reasons for allowance:

As shown in Figure 3 of Yamane et al, DVD decoding structure conventionally comprises overlapping structure (e.g., @ 2500, 3800, and 2300) for retrieving (i.e., demultiplexing) the respective signal components from the combined signal stream. As was previously argued by applicant, the art of record fails to show or fairly suggest separate non-overlapping retrieval units as recited in claim 1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsh D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

DAVID E HARVEY
Primary Examiner
Art Unit 2621